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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,328

02/17/2004

Robert Arnold

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12/15/2004

Robert M. Haroun
SOFER & HAROUN, L.L.P.
Suite 910
317 Madison Avenue
New York, NY 10017

EXAMINER

EVANISKO, LESLIE J

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,328

Applicant(s)

ARNOLD, ROBERT

Examiner

Leslie J. Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of the following informalities: The abstract uses the language "The present invention is directed to..." which is language that should be avoided in the abstract.

Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should **avoid using phrases which can be implied**, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

3. Claims 1-14 are objected to because of the following informalities:

With respect to claim 1, the term "such such" in line 7 should be deleted and replaced with --such-- to correct an obvious typographical error.

With respect to claim 4, it is suggested that the term "--allow--" be inserted before "easy" in line 3 to correct an obvious grammatical error.

With respect to claim 8, line 2, the term "lager" should be deleted and replaced with "--larger--" to correct an obvious typographical error.

With respect to claim 11, line 2, the term "guid" should be deleted and replaced with "--guide--" to correct an obvious typographical error.

With respect to claim 14, line 2, the term "wlit" should be deleted and replaced with "--slit--" to correct an obvious typographical error.

Appropriate correction and/or clarification is required.

4. Claims 6-8 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With respect to claims 6-8, the embossing tool is not part of the claimed combination since claim 1 is directed to the embossing template per se and not the combination of the template and tool. Therefore, the recitation of further details of the embossing tool provided in claims 6-8 are not proper recitations providing any further limitation to the positively claimed structure.

Furthermore, claims 7-8 appear to be functional recitations of the desired mode of operation and are not properly further defining the recited structure.

To correct these problems with respect to claims 6-8, it is suggested that perhaps the claims should be rewritten in independent form and the preamble be directed to an embossing system including the template and embossing tool as recited. In an effort to advance prosecution of the application, the examiner has assumed that claims 6-8 are intended to be drawn to the embossing system including the template and tool.

With respect to claim 14, again the embossed image is not part of the claimed combination, and therefore the recitations of the specific detail of the embossed image in claim 14 is not a proper dependent claim.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-7, and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Carlson et al. (US 2003/0118689). Carlson et al. teach an embossing template comprising an embossing plate 14 having at least one

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embossing opening 24 and a tool guide 12 coupled to the embossing plate and having at least one tool guide opening 22 corresponding to the embossing opening such that when sheet media 26 is inserted between the embossing plate and tool guide, an embossing tool 28 is moved around the edges of the tool guide opening, pressing the sheet media against the edges of the embossing opening, embossing a design into the sheet media. See Figures 1A-3 in particular.

With respect to claims 2 and 3, note Carlson et al. teach various structures that inherently function to ensure the media is properly inserted in the device, including a guide edge (such as the hinged edge shown in the embodiment in Figure 3) and alignment holes 32, 42.

With respect to claims 5 and 7, note paragraph [0017] of Carlson et al.

With respect to claim 6, to the extent this claim is proper, note the embossing tool 28 shown in the Figures has a rounded tip.

With respect to claims 9 and 10, note the embossing openings of Carlson et al. can be considered to be configured to emboss an image in the corner or along an edge of the sheet media as broadly recited.

With respect to claim 11, note the embossing plate and tool guide each have a plurality of corresponding openings as shown in Figures 1A-3.

With respect to claims 12-13, note the plurality of embossing openings can be considered to form different embossed images that can be combined to form a single larger image.

With respect to claim 14, to the extent the claim language is proper, note paragraph [0033] of Carlson et al.

Allowable Subject Matter

7. Claims 4 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 4, the prior art of record fails to teach or fairly suggest an embossing template having all of the structure as recited, in combination with and particularly including, the template having at least two edge guides configured to allow a portion of the tool guide to partially fold

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upward, away from the embossing plate so as to easily position the sheet media within the template.

With respect to claim 8, to the extent that the claim is proper, the prior art of record fails to teach or suggest an embossing system including a template and embossing tool including all of the structure as recited, in combination with and particularly including, an embossing tool having a tip larger than the embossing opening in the embossing plate and the opening offset between the embossing opening and the tool guide opening being larger such that said rounded tip of the embossing tool is able to pass significantly through said tool guide opening to engage said sheet media thoroughly against the edge of the embossing opening.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelson et al. (US 6,237,240 teach a template including alignment holes to aid in aligning the paper. Bourroughs et al. (US 4,537,128), Kraft (US 1,634,466), Taylor (US 5,511,472), and Soucie et al. (US 6,446,549) each teach an embossing template having obvious similarities to the claimed subject matter.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone

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number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
December 12, 2004